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BRANFORD C. WEBB

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EXAMINER

FAY, ZOHREH A

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/870,199
Filing Date: June 05, 1997
Appellant(s): WEBB, BRANFORD C.

Mark Flanigan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 13, 2007 appealing from the Office action mailed April 19, 2007. The previous examiner's answer is vacated and

Art Unit: 1612

that this new examiner's answer addresses the issues in the Board remand dated March 3, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1-56 based on a defective reissue declaration is hereby withdrawn. The Declaration filed on December 22, 2006 has been entered and considered persuasive only with respect to the errors up to that point of the prosecution. However, a supplemental Declaration is

Art Unit: 1612

required once the case is in condition for allowance. Applicant must file the Supplemental Declaration pursuant to MPEP 1414.01.

The rejection of claims 27-30 under 35 U.S.C. 112 first paragraph after further consideration by the examiner is hereby withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 13 is rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Claim 13 is improperly broadened. Such claim removes the limitation “, the series including a final filter having 0.5 UM opening”. Such claims remove the limitation that was relied on for the allowance of the parent application, and thus, cannot be removed. (See MPEP 1412.02). A claim is broader in scope than the original claims if it contains within its scope any conceived product or process, which would have infringed the original patent. A claim is broaden if it is broader in any one respect even though it might be narrower in other respects.

Claims 13-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 13-23 are directed to the phrase filtering the gel through a series of filter to form a clear solution". The specification has support for certain filters with specific um opening. However, the specification fails to provide support for the broad phrase of "a series of filters" in general with many possible openings.

Claims 1-12 and 24-54 at present time are considered to be allowable.

(10) Response to Argument

Appellant's arguments and remarks regarding the broadening of claim 13 have been carefully considered, but are not deemed to be persuasive. Appellant in his remarks argues that the examiner is rejecting claim 13 based on the recapture rule. Appellant goes on by saying that there is no evidence of record that the limitation of "the series including a final filter having 0.5 um opening" was relied upon for the allowance of the parent application. The arguments are not well taken. Appellant in the 132 declarations submitted on September 19, 2000 indicates the importance of the filtering process. Such declarations indicate that the unexpected properties of Cellugel

Art Unit: 1612

material are due to the inventive filtering process, which removes the particulates and undesirable molecular weight components. It is also indicated that the removal of the particulate materials greater than 0.5 um prevents the cloudiness, which makes it difficult to see clearly during surgery. Therefore, the removal of the phrase “, the series including a final filter having 0.5 um openings” shows the existence of the particulates greater than 0.5 um, the factor that was considered in the patentability of the parent application.

Appellant's arguments regarding the 112 first paragraph have also been carefully considered, but are not deemed to be persuasive. Applicant refers to column 6, lines 3-12 of the specification for support for the phrase "filtering gel through a series of filters". However, column 6, lines 3-12 are drawn to a set of specific filters with the specific size and not a set of filters in general. Appellant's arguments regarding the submission of a Supplemental Declaration filed on December 22, 2006 have been noted. Such declaration has been entered and considered persuasive only with respect to errors up to that point of prosecution. However, a supplemental Declaration is required once the case is in condition for allowance. Appellant must file the Supplemental Declaration pursuant to MPEP 1414.01.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Art Unit: 1612

Respectfully submitted,

/Zohreh A Fay/

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